

R E M A R K S

Claims **1 - 14** are pending in the present application.

Claims **1 - 3, 6, 7, 9 - 14** were presented for examination.

Of the examined claims, claims **1, 6 and 7** are independent.

Claims Not Examined

In summary, pending dependent claims **11 - 14** were not examined, and so the next Office Action cannot be a final rejection.

In Applicants' amendment of August 2, 2004, new claims **9 - 14** were added. See pages 5 - 8 (setting forth new claims 9 - 14) and page 10 (explaining that new claims **9 - 14** were being added). All those new claims depend (directly or indirectly) from independent claim 1.

In the latest Office Action, the Examiner incorrectly asserts that new claims **9 and 10** (rather than **9 - 14**) were added, and the Examiner did not examine pending claims **11 - 14**.

Since dependent claims **11 - 14** were not examined, they were obviously never rejected on any basis. Since they were not rejected, any rejection of dependent claims **11 - 14** in the next Office Action would be a new ground of rejection of such claims. Thus, the next Office Action with new grounds of rejection cannot be final. MPEP 706.07(a). The new grounds of rejection cannot be based on amendments of the claims (the present Response does not include any amendments), and the new grounds of rejection cannot be based on information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. § 1.97(c).

Accordingly, since dependent claims **11 - 14** were never examined or rejected, the next Office Action cannot be a final Office Action.

Section 101 Rejections

Claims **1 - 3, 9 and 10** were rejected as nonstatutory. We traverse this rejection as the basis used is not founded in the law.

The rejection is apparently based on the mistaken notion that claims must "require structure interaction or mechanical intervention" and / or cannot "be performed without a physical structure or mechanical object". Office Action, page 3.

The Examiner agrees that all claims produce a useful, concrete and tangible result. Office Action, page 3. This standard is the only standard that must be satisfied, and accordingly the claims are statutory. See, e.g., State Street Bank v. Signature Financial Trust, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1601 (Fed. Cir. 1998), cert. denied, 119 S. Ct. 851 (1999); AT & T Corp. v. Excel Communications Inc., 172 F.3d 1352, 1356, 50 USPQ2d 1447, 1451 (Fed. Cir. 1999).

If this rejection is maintained, please provide a basis in either a precedential case law or an agency rule which defines this standard, or which overrules or limits the holdings of the two Federal Circuit cases stated in the above paragraph.

Claim Objections

Claims **6 and 7** are objected to under 37 C.F.R. § 1.75(c) as being in improper dependent form.

The Applicants and the Examiner agree that claims **6 and 7** are not dependent claims - they are independent claims. Applicants have in fact paid the fee for claims **6 and 7** as independent claims.

The Examiner apparently believes that it is improper for an independent claim (such as claims **6 and 7**) to include a reference to a prior claim. However, many types of independent claims properly include a reference to a prior claim. See, e.g., MPEP 2173.05(f) (reference to limitations in another claim are acceptable); MPEP 608.01(n)(II) (an independent "product-by-process" claim refers to prior claim).

Section 103 Rejections

Claims **1 - 3, 6, 7, 9 and 10** have been rejected as obvious in light of a combination of Walker (U.S. Patent No. 6,119,099) and Wollaston (U.S. Patent No. 6,061,506). We traverse this rejection, since there has not been a *prima facie* showing of obviousness.

Walker is not applicable prior art.

Walker is neither a 102(b) nor a 102(e) reference which may be used in an obviousness rejection as proposed by the Examiner.

Walker is not a reference under 35 U.S.C. § 102(b) because the Walker patent published on September 12, 2000, which is less than one year before the priority date of the present utility application, which claims priority to a provisional application filed on November 14, 2000.

Walker cannot be used as a reference under 35 U.S.C. § 102(e) against the present application because Walker and the present application were, at the time the invention was made, commonly owned or subject to an obligation of assignment that would establish common ownership. See MPEP 706.02(1)(1).

No motivation to combine

Further, no motivation to combine has been set forth. Notably, the reason to combine proposed by the Examiner is "in order to optimize query". This has nothing to do with Walker or with the present claims, and thus would not motivate the proposed combination.

"To establish a *prima facie* case of obviousness ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings"

MPEP 2143.

Conclusion

If the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Respectfully submitted,



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Date

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